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REMARKS***Amendment to the Claims***

Most of the amendments are in response to the 112, second paragraph rejections which are further explained below. It is believed that no new matter has been added. Claims 1-11 are still pending.

35 U.S.C. 112, first paragraph rejection

The points made in the examiner's office action are addressed below as follows:

- (1) It is unclear what is the factual basis as to why the examiner believes the element of "activator" was not possessed by the applicants' at the time the invention was filed. The examiner himself appears to acknowledge this in addressing the term "activator" in the subsequent 35 U.S.C. 112, second paragraph rejection.
- (2) It is unclear what is the basis for lack of written description here as it is well-known that a superabsorbent is a species of absorbent. As such, the recitation on page 3 of the specification is the standard practice of following a broad recitation with a narrower recitation. Again, there is no assertion that the applicants did not possess the claimed invention at the time it was filed.

35 U.S.C. 112, second paragraph rejection

The points made in the examiner's office have been addressed as follows:

- (1) "Sidedly" has been amended to recite ---sided---.
- (2) Although not believed to be necessary, the "of" after comprises has been deleted.
- (3) MPEP 2111.01 states that terms not defined in the specification are given their "plain meaning". It is unclear why this plain meaning is deemed to be vague and indefinite by the examiner as this is a well-known term in the art as being an agent which promotes polymerization of a monomer (in this case to form polyurethane). The applicants' representative may have earlier indicated to the examiner in other office actions that in the age of *Festo*, applicants cannot afford to guess at what the examiner will find to be appropriate language and attention is directed to MPEP 2173.02:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, *not whether more suitable language or modes of expression are available*. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. *Examiners are encouraged to suggest claim language to applicants to improve clarity or precision of the language used, but should not reject claims or insist on their own*

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preferences if other modes of expression selected by applicants satisfy the statutory requirement. (see MPEP 2173.02)

- (4) Although not believed to be necessary, appropriate Markush has been added.
- (5) It is presumed that the confusion stemming from the use of the term "optionally" came from the lack of antecedent basis for the term "cut edges" as otherwise the meaning of the claim was fairly straightforward. The lack of antecedent basis has been corrected (see e.g. page 6, lines 6-9 for support for the amendment to address lack of antecedent basis).
- (6) The capitalized EBC has been spelled out (see also page 2, second to last line from end of page, of specification).
- (7) Unclear what the examiner is referring to as claim 6 as filed had no line 4.
- (8) The claim has been amended to recite claims 1-10.

35 U.S.C. 103(a) rejection

Claims 1-11 were rejected by the examiner as being obvious over applicants' alleged admission in view of either Ganster et al. (U.S. Patent 6,191,216). (It is presumed that this is the intended supporting reference for the examiner's rejection as U.S. Patent 6,191,216 is an English language equivalent of WO 97/43328 of which Ganster is also the first named inventor)

Summary of response to 103(a) rejection

- (1) Applicants' "admission" discloses less of the applicants' invention than that asserted by examiner.
- (2) No usable motivation from within the applicants' admission with teachings of Ganster et al.
- (3) Ganster et al. does not teach the polyurethane needed to be combined with applicants' "admission".
- (4) Evidence of secondary consideration was not considered.

Applicants' "admission" discloses less of the applicants' invention than that asserted by examiner

In describing the state of the prior art, the applicants refer to prior art which describes certain elements of the applicants invention. It appears that the applicants and the examiner are in agreement that the "admission" does not teach the use of the polyurethane-based adhesive described in the applicants' claim 1, section b).

However, the applicants also assert that the "admission" does not direct one of ordinary skill in the art to a single sided or double sided strip which comprises of a backing composed of a film having a

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tensile strength of 2-20 N/cm and an elongation at break of 200-800%.

No usable motivation from within the applicants' admission with teachings of Ganster et al.

While there must be motivation to combine the references in order to establish a *prima facie* case of obviousness, the use of an applicants' "admission" provides special burdens for maintaining this motivation to combine references as MPEP 2143 states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)"

Whatever motivation there may be to combine the teaching of the applicants' admission with Ganster et al. cannot come from the applicants' disclosure which also happens to be the primary reference for the rejection.

Ganster et al. is of no assistance in providing motivation for combining with the elements of the applicants' admission as there is no direction or guidance for making such a combination even without the teaching away referred to by the applicants' last paragraph of page 1 of the specification and the direction or guidance for making the combination is even weaker still when the teaching away is considered.

Ganster et al. does not teach the polyurethane needed to be combined with applicants' "admission"

Even if it were permitted to disregard the claimed invention and prior art as whole and simply combine the elements as needed without any recitation of motivation to do so, the combination of the applicants' admission and Ganster et al. still would not replicate the applicants' claimed invention because Ganster et al. does not describe the applicants' polyurethane adhesive. Even when giving Ganster et al. the best possible scope for their invention in order to support the examiner's rejection, Ganster et al. teaches a polyurethane adhesive which is far different than that claimed by the applicants (see chart below):

Applicants' polyurethane-based adhesive (claim 1)	Ganster et al. (U.S. Patent 6,191,216 - col. 2, lines 5-21)
60-80% by weight of an aliphatic isocyanate/polyol crosslinking system	hexamethylene diisocyanate or a modified hexamethylene diisocyanate polyetherpolyols with 2 to 6 hydroxyl groups and having OH values of 20 to 112 and an ethylene oxide (EO) content of ≥ 10 wt. %
15-35% by weight of a filler	
0.05 - 0.20% by weight of an activator	
	anti-oxidants

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	bismuth(III) carboxylates soluble in the above polyols and based on carboxylic acids having 2 to 18 C atoms as catalysts
	wherein the product of the functionalities of the polyurethane-forming components (hexamethylene diisocyanate and polyetherpolyols) is at least 5.2, the quantity of the catalyst amounts to 0.005 to 0.25 wt. %, relative to the polyols, the quantity of anti-oxidants is within the range of ≥ 0.1 wt. %, relative to the polyols and a ratio of free NCO groups in the hexamethylene diisocyanate to the free OH of the polyols is from 0.30 to 0.70.

Not only must it be presumed that the additional elements of Ganster et al. are inherent parts of the applicants' invention (as there is no evidence that removal of any of their elements would still result in an a product with proper enablement), one of ordinary skill in the art must not only presume that the missing elements are part of Ganster's invention and further still that the proper amounts are also taught by Ganster et al.

With regard to the inclusion of additional elements to Ganster's invention, even if Ganster et al. were to mention these elements in passing in the specification, this still would not render the resulting polyurethane adhesive to be obvious as one could not ignore the multitude of other potential ingredients taught by Ganster et al. As stated in *In re Rice*, 178 USPQ 478 (CCPA 1973) "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed.'" *Id.* at 480.

Even by climbing the hurdle presented by *Rice*, there still would be no motivation for the specific amounts of elements claimed by the applicants. MPEP 2144.05 section II (Optimization of Ranges) states that "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977)." Ganster et al. makes no such assertions with regard to the missing elements and the phalanx of limitations which intrinsically tie each of Ganster's elements together into an indivisible whole would appear to make it very difficult (if not impossible) to argue that one could optimize any variable in their invention.

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Evidence of secondary consideration was not considered

The last of the *Graham* factors for determining obviousness is the at evidence of secondary considerations will be evaluated. The applicants hold that the evidence presented on pages 5 and 6 show evidence of "unexpected results".

The last paragraph on page 1 of the applicants' specification described the problems in the prior art with regard to the use of polyurethane adhesives with adhesive tape strips. DE 196 18 825 was provided as evidence that the use of some polyurethane adhesives was unsuitable for consumer applications. Disclosure of WO 97/43328 (Ganster et al.) was provided as further evidence as to its unsuitability. While the former represents a clear teaching away, perhaps the examiner could argue that Ganster et al. does not represent a clear teaching away but merely a non-preferred embodiment as the unsuitability of the product was made clear only after Solila irradiation.

However, the polyurethane adhesives used in the applicants claimed invention when subjected to the same Solila irradiation surprisingly did not exhibit the discoloration and exudation seen by the Ganster et al. adhesive (see page 6, lines 10-16). This would appear to be the objective evidence that the examiner had asked for in his office action.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (10 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **29 December 2003**

By: Howard C. Lee
Howard C. Lee